



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Paper No. None

BINGHAM, MCCUTCHEN LLP
THREE EMBARCADERO CENTER
18 FLOOR
SAN FRANCISCO CA 94111-4067

COPY MAILED
MAY 24 2006
OFFICE OF PETITIONS

In re Application of :
Wei Ming Hu et al. :
Application No. 09/223,660 : DECISION ON PETITION
Filed: December 30, 1998 :
Attorney Docket Number: :
237/117 :
Title: METHOD AND SYSTEM FOR :
DIAGNOSTIC PRESERVATION OF :
THE STATE OF A COMPUTER :
SYSTEM :

This is a decision on the petition filed April 13, 2006, under 37 C.F.R. §1.137(a)¹, to revive the above-identified application.

BACKGROUND

The above-identified application became abandoned for failure to submit the issue fee and drawings in a timely manner in reply to

-
- 1 A grantable petition pursuant to 37 C.F.R. §1.137(a) must be accompanied by:
- (1) The reply required to the outstanding Office action or notice, unless previously filed;
 - (2) The petition fee as set forth in 37 C.F.R. §1.17(1);
 - (3) A showing to the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unavoidable;
 - (4) Any terminal disclaimer (and fee as set forth in 37 C.F.R. §1.20(d)) required pursuant to paragraph (d) of this section.

the Notice of Allowance and Issue Fee Due, mailed July 12, 2005, which set a shortened statutory period for reply of three (3) months. No extensions of time are permitted for transmitting formal drawings or issue fees². Accordingly, the above-identified application became abandoned on October 13, 2005. A Notice of Abandonment was mailed on February 27, 2006.

With the present petition, Petitioner has submitted corrected drawings, and has asserted that the Notice of Allowance and Issue Fee Due was not received. Both the petition fee and the issue fee have been charged to Petitioner's Deposit Account, as authorized in the petition.

Petitioner has met requirements (2) and (3) of 37 C.F.R. §1.137(a). The fourth requirement is not applicable.

Regarding the first requirement, the requirement has not been satisfied because Petitioner did not submit the required reply to the Office action in full. The required reply is the reply sufficient to have avoided abandonment, had such reply been timely filed³. In order for the application to be revived, petitioner must submit a reply which satisfies 37 C.F.R. §1.137(a)(1) (i.e., both the issue fee and acceptable corrected drawings). As indicated above, the issue fee has been charged to Petitioner's Deposit Account. The drawings Petitioner has submitted cannot be accepted however, for they have been reviewed by the Draftsperson and have been objected to. A Notice of Draftsperson's Patent Drawing Review has been enclosed with this decision.

Regarding the alleged non-receipt of the Notice of Allowance and Issue Fee Due, a discussion follows:

RELEVANT PORTION OF THE MPEP

MPEP 711.03(c) states, in part:

PETITION TO WITHDRAW HOLDING OF ABANDONMENT BASED ON FAILURE TO
RECEIVE OFFICE ACTION

In *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of *Delgar*, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning

² See MPEP §710.02(e).

³ See M.P.E.P. 711.03(c).

of Delgar is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee (35 U.S.C. 151) or for failure to prosecute (35 U.S.C. 133).

To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. For example, if a three month period for reply was set in the nonreceived Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. See Notice entitled "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 O.G. 53 (November 16, 1993).

The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions).

Evidence of nonreceipt of an Office communication or action (e.g., Notice of Abandonment or an advisory action) other than that action to which reply was required to avoid abandonment would not warrant withdrawal of the holding of abandonment. Abandonment takes place by operation of law for failure to reply to an Office action or timely pay the issue fee, not by operation of the mailing of a Notice of Abandonment. See *Lorenz v. Finkl*, 333 F.2d 885, 889-90, 142 USPQ 26, 29-30 (CCPA 1964); *Krahn v. Commissioner*, 15 USPQ2d 1823, 1824 (E.D. Va 1990); *In re Application of Fischer*, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988).

Two additional procedures are available for reviving an application that has become abandoned due to a failure to reply to an Office Action: (1) a petition under 37 CFR 1.137(a) based upon unavoidable delay; and (2) a petition under 37 CFR 1.137(b) based on unintentional delay.

See also 1156 O.G. 53 (October 25, 1993), which may be viewed at <http://www.uspto.gov/web/offices/com/sol/og/con/files/cons074.htm>.

Petitioner has not established non-receipt of the Notice of Allowance and Issue Fee Due, for although he has included a statement that the Office communication was not received by the Practitioner, he has not:

- Attested to the fact that a search of the file jacket and docket records indicates that the Office communication was not received, and;
- Provided a copy of the docket record where the non-received Office communication would have been entered had it been received and docketed.

CONCLUSION

In view of the above, this petition must be **DISMISSED**.

Any request for reconsideration of this decision under 37 C.F.R. §1.137(a) must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The request for reconsideration should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.137(a)," and should only address the deficiencies noted in this decision.

The renewed petition should display "Please deliver to Paul Shanoski, c/o Office of Petitions" in a prominent manner. Any renewed petition may be submitted by mail⁴, hand-delivery⁵, or facsimile⁶.

The alternate petition under 37 C.F.R. §1.137(b) will be held in abeyance so as to afford Petitioner the opportunity to file a renewed petition under the unavoidable standard. If Petitioner would prefer to seek revival under the unintentional standard, a response to this decision should be submitted with words to this effect.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225. All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.



**Paul Shanoski
Senior Attorney
Office of Petitions
United States Patent and Trademark Office**

4 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

5 Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.

6 (571) 273-8300 - please note this is a central facsimile number.